

29. The method of **Claim 1**, wherein, in association with step "a," there is further included the step of:

using a block of material as recited in Claim 1 which also is symmetrical about the center-line-plane defined by the plane through the centers of the user's nose and chin.

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*- Remarks -*

Claims 1-5, 7-9, 11-20 and 21-29 are in the case, for a total of 27 claims, two of which are independent claims. **Please charge the excess claims fee of \$63.00 (7x9) for the 7 additional claims to the Deposit Account No. 16-2605/WillD2 of the undersigned.** Small entity status exists. Two extra copies of this page are attached.

Claim 6 (now deleted), originally dependent on Claim 1, was indicated as being allowable if rewritten in independent form. Claim 21 is based on the combination of Claims 1+6 and now likewise should be fully allowed, while Claims 22-27, dependent directly or indirectly on Claim 21 should likewise be allowed.

Claims 11-20 have already been allowed.

With respect to Claim 1 and its remaining, original dependent claims, it is noted that they (except Claim 4) were rejected on the Stokesbary (6,219,865) patent under 35 USC 103, which patent has a filing date of March 31, 2000 and recites a

priority date of April 2, 1999.<sup>1</sup> However, the present invention was made, both by conception and reduction to actual practice, at least as early as November 2, 1998, as established by the accompanying, "swearing back" declaration of the attorney of record, namely, the undersigned counsel,<sup>2</sup> who witnessed and dated the inventor's written disclosure document on November 2, 1998 and took a series of documenting photographs of an actual, working prototype in connection with an office conference with the inventor on that date.

Thus, the Stokesbary patent is not available as a reference against the claimed invention.

Claim 1 and its dependent claims (except Claim 4) also were rejected on the White (2,774,601) patent under 35 USC 103. However, the White device is one "for use in playing golf" (title) in which the device is used while the user (a golfer) is **standing and actively moving** (essentially exercising) in contrast to the invention's

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<sup>1</sup> The priority document has not been made of record in this application and neither the undersigned counsel nor the inventor is currently aware of its contents to determine if Stokesbary is in fact entitled to an April 2, 1999 date with respect to the issue at hand, and, therefore, no admission of that date is being made herein. However, in view of Dr. Williams' entitlement to at least a November 2, 1998 date of conception and actual reduction to practice of his claimed invention, Stokesbary's recited date of priority is moot.

<sup>2</sup> Because the declaration of counsel involved a statement concerning counsel's legal opinion that the relevant claims "read on" the actual prototype of November 2, 1998, and counsel's knowledge of the facts authenticating the date of November 2, 1998 was at least as great as the inventor's (Dr. Williams), it was thought that counsel's declaration would be more probative than the inventor's. However, if the Examiner wishes one, an inventor's declaration confirming the facts of the accompanying declaration and expanding on the prototype of November 2, 1998 could be prepared and filed. **The Examiner is requested to call counsel (860-668-2433) if an inventor's declaration is desired.**

use in the **method** Claim 1 while the user is “**sitting in a seat**” and “**relaxing**” (Claim 1) while “**traveling**” (Claim 28). Additionally, the device is **NOT** “symmetrical about its center-line plane” (see Claim 29) but instead has a raised portion (18) at one side end which was specifically and necessarily included in White to over come a natural tendency of the golfer so that instead the raised protrusion “serves to maintain sufficient pressure on the device to prevent accidental dislodgment thereof when the back swing as well as the down swing, is properly executed” (col. 2, lines 55-69 and see Figs. 2-4, element 18).

Thus, on reconsideration, the “103” rejection based on the golfer’s device of White, it is respectfully submitted, should be withdrawn.

The cited but not applied McElvenny patent has been reviewed but it is respectfully believed that it fails to cure the problems of the White patent as applied against the present invention of Claims 1+.

It is respectfully submitted that the Examiner apparently is distorting the White golfer’s aid in an inappropriate attempt to suggest the present invention, particularly as claimed in re-written Claim 1 and its dependent claims, guided only by hindsight in light of the inventive teachings of the present invention. Such is not proper under 35 USC 103.

It is respectfully suggested that the use of the White reference is only being guided by hind-sight, and is inappropriately distorting a disparate devices in a way which those of ordinary skill would not be directed to do in the “real world” context of the prior art.

It is further respectfully believed that, if the Examiner maintains the current "103" rejection, the Examiner, in forcing White to try to produce the presently claimed invention in Claims 1+ to meet the claimed invention, would be relying upon "hindsight," guided only by the innovative and market successful teachings of the present invention, in contravention of accepted jurisprudence. For example, the CAFC has said<sup>3</sup> in the Fine decision:

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.' It is essential that 'the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made...to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.'

(*Id.*) One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Indeed the patent to White (as well as the other prior references of record) not only do **not** provide any teaching which would lead one to use any of them individually or combination in a way which would meet the claimed invention, the

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<sup>3</sup>Quoting from W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983).

prior references, including particularly the White patent, actually teach away from, and even directly against, the present invention.

It is respectfully asserted that the claimed methods of the present invention of Claims 1+ are superior and non-obvious in light of the prior art, and the previous §103 rejection of the initial Office Action using White, should be withdrawn, as not being pertinent to the present claims, as well as erroneous.

The Court of Appeals for the Federal Circuit has summarized some of the basic tenets to be applied under 35 USC 103 in what one reporter<sup>4</sup> has termed the “Section 103 Bible.” As stated by the CAFC<sup>5</sup> (all emphasis added):

“...the following tenets of patent law...must be adhered to when applying

Section 103:

(1) the claimed invention must be considered as a whole<sup>6</sup> (although the difference between claimed invention and prior art **may seem slight, it may also have been the key to advancement of the art**);

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<sup>4</sup>The American Bar Association's Section of Litigation's Court of Appeals for the Federal Circuit NEWSLETTER, Vol. III/No. 6, January 1987 - June 1987, at page 214.

<sup>5</sup>Hodosh v. Block Drug Co., 786 F.2d 1136, 229 USPQ 182, 187, footnote 5 (Fed. Cir. 1986).

<sup>6</sup>Citing the following authority: 35 USC 103; and e.g. Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984).

(2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination;<sup>7</sup>

(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention;<sup>8</sup>

(4) 'ought to be tried' is not the standard with which obviousness is determined;'<sup>9</sup>

Under these tenets the claimed invention is "unobvious" under §103. Accordingly, it is respectfully requested that the original rejection of Claims 1+ be reconsidered and dropped, allowing these claims as well.

Accordingly, further consideration and allowance of all of the present claims are respectfully requested.

As noted above, Claims 1-5, 7-9, 11-20 and 21-29 are in the case. Thus, there is a total of 27 claims, two of which are independent claims, resulting in an excess claim fee of \$63.00 (7x\$9) being due.<sup>10</sup> Additionally, Applicant is concurrently filing an appropriate extension of time request, resulting in an extension fee being due of \$460.00, for a total due of \$523.00 being due. A check in that amount is attached.

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<sup>7</sup>Citing e.g., Lindermann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

<sup>8</sup>Citing e.g., W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

<sup>9</sup>Citing Jones, *supra*, 727 F.2d at 1530, 220 USPQ at 1026.

<sup>10</sup> Small entity status exists in this application.

Please charge any additional fees that may be due to the Deposit Account No. 16-2605/WillD2 of the undersigned.

It is believed the application is now in condition for full allowance, and such action is respectfully requested.

Respectfully submitted:



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*- Certificate of Mailing -*

I hereby certify that this "Response," along with a three (3) month extension of time request with a \$523.00 fee payment and a "Swearing Back" Declaration of Counsel, are being sent by first class mail with proper postage in an envelope addressed to the "Commissioner for Patents, Washington, D.C. 20231" on this **August 22, 2002.**



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8/22/2002